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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,322	11/27/2001	Michael L. Gough	NEO1P026.US02	3459
45965 7590 08/10/2007 TECHNOLOGY & INTELLECTUAL PROPERTY STRATEGIES GROUP PC dba TIPS GROUP P. O. BOX 1639 LOS ALTOS, CA 94023-1639			EXAMINER PHAM, KHANH B	
			ART UNIT 2166	PAPER NUMBER
			MAIL DATE 08/10/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/997,322

Examiner

Khanh B. Pham

Applicant(s)

GOUGH ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 33-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 33-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The amendment filed August 23, 2006 has been entered. Claims 37, 40 have been amended. Claims 1, 33-51 are pending in this Office Action.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 1, 33-51 are rejected under 35 U.S.C. 102(e)** as being anticipated by Budge et al. (US 6,014,689 A), hereinafter "Budge".

As per claim 1, Budge teaches a method for providing an audiovisual e-mail system (Col. 1 lines 34-52) comprising:

- "providing a server connected to a network" at Col. 1 lines 18-23;
(Budge teaches an e-mail sever connected to the Internet)
- "inputting a message and an audiovisual enhancement which is associated with said message from a sender into said server, said message to be sent as an e-mail to at least one recipient on said network" at Col. 1 lines 53-64;

(Budge teaches the step of associating video and audio data (i.e., "audiovisual enhancement") to a video e-mail message)

- "associating said message with a self-executing programmable enhancement operative to stream said audiovisual enhancement, at least in part, from said server over said network and to display said audiovisual enhancement in conjunction with said message" at Col. 2 lines 2-10 and Col. 8 lines 10-25;

(Budge teaches a self-executable video e-mail player attached to the e-mail message, the player decodes input bitstream and displaying video and audio data in the e-mail message)

- "and sending said e-mail over said network to said at least one recipient" at Col. 2 lines 25-27.

As per claim 33, Budge teaches a method as recited in claim 1 wherein "said audiovisual enhancement includes both audio and visual components" at Col. 1 lines 39.

As per claim 34, Budge teaches a method as recited in claim 1 wherein "said audiovisual enhancement includes only an audio component" at Col. 2 lines 10-11.

As per claim 35, Budge teaches a method as recited in claim 1 wherein "said audiovisual enhancement includes only a visual component" at Col. 2 lines 10-11.

As per claim 36, Budge teaches a method as recited in claim 1, wherein "said audiovisual enhancement includes a streaming video displayed within a window of a recipient's machine" at Col. 5 lines 4-17.

As per claim 37, Budge teaches a method as recited in claim 1 wherein "said audiovisual enhancement is developed on a sender's machine, and is transmitted to said server over said network" at Col. 1 lines 36-44.

As per claim 38, Budge teaches a method as recited in claim 37 wherein "said network includes a TCP/IP network" at Col. 1 lines 20-21.

(Budge teaches the network includes the Internet, which is the network that uses TCP/IP protocol)

As per claim 39, Budge teaches a method as recited in claim 38 wherein "said network includes the Internet" at Col. 1 lines 20-21.

As per claim 40, Budge teaches computer program segments embodied in computer readable media to provide an audiovisual e-mail system comprising:

- "a code segment transmitting over a network to a server an audiovisual enhancement which is associated with a message from a sender, said message to be sent as an e-mail to at least one recipient on said network" at Col. 1 lines 53-64;
- "a code segment associating said message with a self-executing code segment operative to stream said audiovisual enhancement, at least in part, from said server over said network and to display said audiovisual enhancement in conjunction with said message upon the selection of said message by said at least one recipient" at Col. 2 lines 2-10 and Col. 8 lines 10-25.

As per claim 41, Budge teaches computer program segments embodied in computer readable media to provide an audiovisual e-mail system as recited in claim 40

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wherein "said audiovisual enhancement includes both audio and visual components" at Col. 1 lines 39.

As per claim 42, Budge teaches computer program segments embodied in computer readable media to provide an audiovisual e-mail system as recited in claim 40 wherein "said audiovisual enhancement includes only an audio component" at Col. 2 lines 10-11.

As per claim 43, Budge teaches computer program segments embodied in computer readable media to provide an audiovisual e-mail system as recited in claim 40 wherein "said audiovisual enhancement includes only a visual component" at Col. 2 lines 10-11.

As per claim 44, Budge teaches computer program segments embodied in computer readable media to provide an audiovisual e-mail system as recited in claim 40 wherein "said audiovisual enhancement includes a streaming video displayed within a window of said recipient's machine" at Col. 5 lines 4-17.

As per claim 45, Budge teaches computer program segments embodied in computer readable media to provide an audiovisual e-mail system as recited in claim 40 wherein "said audiovisual enhancement is developed on a sender's machine" at Col. 1 lines 36-44.

As per claim 46, Budge teaches an audiovisual e-mail system comprising:

- "means transmitting over a network to a server from a sender machine an audiovisual enhancement which is associated with a message from said sender",

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said message to be sent as an e-mail to at least one recipient on said network" at Col. 1 lines 53-64; and

- "means associating said message with a self-executing program operative to stream said audiovisual enhancement, at least in part, from said server over said network and to display said audiovisual enhancement in conjunction with said message on a recipient machine upon the selection of said message by said at least one recipient" at Col. 2 lines 2-10 and Col. 8 lines 10-25.

As per claim 47, Budge teaches an audiovisual e-mail system as recited in claim 46 wherein "said audiovisual enhancement includes both audio and visual components" at Col. 1 lines 25-27.

As per claim 48, Budge teaches an audiovisual e-mail system as recited in claim 46 wherein "said audiovisual enhancement includes only an audio component" at Col. 2 lines 10-11.

As per claim 49, Budge teaches an audiovisual e-mail system as recited in claim 46 wherein "said audiovisual enhancement includes only a visual component" at Col. 2 lines 10-11.

As per claim 50, Budge teaches the audiovisual e-mail system as recited in claim 46 wherein "said audiovisual enhancement includes a streaming video displayed within a window of said recipient's machine" at Col. 5 lines 4-17.

As per claim 51, Budge teaches the audiovisual e-mail system as recited in claim 46 wherein "said audiovisual enhancement is developed on said sender's machine" at Col. 1 lines 36-44.

Response to Arguments

4. Applicant's arguments filed August 23, 2006 have been fully considered but they are not persuasive. The examiner respectfully traverses applicant's arguments.

Regarding claim 1, applicant argued that Budge does not teach or suggest associating said message with a self-executing programmable enhancement operative to stream said audiovisual enhancement, at least in part, from said server over said network." The examiner respectfully disagrees.

First, applicant argued that Budge merely attaches an audiovisual file to an e-mail message, but does not associates it with the email message. On the contrary, there is no different between attaching a file to an email and associating a file to an email.

Second, applicant argued that Budge's audiovisual file is not streamed over the network. On the contrary, Techweb Encyclopedia defines "streaming" as "Transferring or transmitting data". Budge teaches the video file is transferred from a sender to an E-mail client computer and therefore anticipated the claimed limitation.

Third, applicant argued that Budge does not teaches "self-executing", However, Budge teaches that the video e-mail message are sent as "self-contained executable

video files", so that the video files can be played by itself, without the need of an external player (i.e. "self-executing".)

"a significant feature of this invention is the ability to **attach an executable version of the video e-mail player 220 to a video e-mail message file 500.** This feature allows the receiving sub-system 4 to play a video e-mail message **without the necessity of previously installing special software** at the receiving sub-system 4, such as the video email player 220"
(Budge, Col. 6 lines 5-12.)

In light of the foregoing arguments, the 35 U.S.C 102 rejection is hereby sustained.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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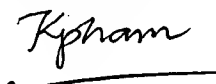
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh B. Pham whose telephone number is (571) 272-4116. The examiner can normally be reached on Monday through Friday 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on (571) 272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Khanh B. Pham
Primary Examiner
Art Unit 2166



August 7, 2007